UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,458	10/29/2001	Josephine Telesca	J6701(C)	1622

201 7590 06/23/2004

UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER	
GHALI, ISIS A D	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,458	TELESCA ET AL.	
	Examiner	Art Unit	
	Isis Ghali	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/29/01, 2/15/02, 7/31/02, 10/7/02, 10/16/02, 4/7/03, 4/21/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of IDS, filed 10/29/2001; IDS, filed 02/15/2002; IDS, filed 07/31/2002; IDS, filed 10/07/2002; IDS, filed 10/16/2002; IDS, filed 04/07/2003, and IDS, filed 04/21/2003.

Priority

1. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the

application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/022,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim and the claims the copending applications are potentially conflicted. The claims of both of the applications are directed to product comprising transparent strip and an imaging substrate and method of its use to evaluate the efficacy of a cosmetic that affect the texture of the skin as wrinkles. The present claims directed to kit that anticipate the claims of the copending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/370,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim and the claims the copending applications are potentially conflicted. The claims of both of the applications are directed to product comprising transparent strip and an imaging substrate and method of its use to evaluate the efficacy of a cosmetic that affect the texture of the skin as wrinkles. The present claims directed to kit that anticipate the claims of the copending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

5. The use of the trademarks "DeSquame" and "Flexcon" have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: between step (B) after applying the cosmetic product and step (C) placing the adhesive surface of the strip against the skin treated with the cosmetic product. It is not defined in the claims or in the specification when the adhesive strip is placed? Is it right after the application of the cosmetic product and on top of it, or after elapsing of time of action of the cosmetic product to evaluate its effect? Clarification is requested.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,088,502 ('502).

US '502 disclosed a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The claims are anticipated by the reference since it has been held by the court that when the only difference between the prior art product and the claim is the "written instruction to the consumer", the claim is anticipated by the art. See *In re Ngai 03-1524.*

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '502 in view of US 6,270,783 ('783).

The teachings of US '502 are discussed above, however, the reference does not teach the adhesive as acrylic adhesive.

US '783 teaches a skin adhesive strip comprising a substrate and an adhesive layer with the most preferred adhesive is the acrylic polymer as it provides the required tackiness to the skin (abstract; col.4, lines 38-43, 38-39, 57).

Thus, it would have been obvious to one having ordinary skill in the art at he time of the invention to provide the adhesive strip disclosed by US '502 and select the acrylic adhesive polymer motivated by the teaching of US '783 that the acrylic adhesive is the most preferred as it provides the required tackiness to the skin, with reasonable expectation of having strip comprising an acrylic adhesive and substrate that provides the required tackiness to the skin of the user.

13. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 564,573 (573) in view of US '502.

US '573 discloses a device used to three-dimensionally map the skin structure as exactly, a very high resolution of the measured values being essential for the purpose of proving the effect of skin treatment preparation in order to be able to detect changes in skin structure at interval time by analyzing the map on an adhesive sheet (col.1, lines 9-15; col.3, lines 50-60). The device comprises transparent sheet with adhesive side and a support sheet (abstract; col.3, lines 15-20).

The reference does not teach placing the sheet on dark imaging substrate. However, the reference recognized three-dimensional mapping the skin surface to evaluate the effect of the skin treatment, and one with ordinary skill in the art would have mapped the skin surface using a powder or adhesive. No superior and unexpected result of record to show the criticality of using the dusting powder, absent evidence to the contrary.

US '502 teaches a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The device provides easy application with repeatable results for uniform testing of skin surface (col.2, lines 34-35).

Thus, it would have been obvious to one having ordinary skill in the art the time the invention was made to provide a method for evaluating efficacy of cosmetic

treatment on the skin surface by mapping the texture of the surface of the skin as disclosed by US '573, and use the device comprising dark imaging substrate to visualize the obtained texture as disclosed by US '502, motivated by the teaching of US '502 that the device provides easy application with repeatable results for uniform testing of skin surface, with reasonable expectation of having a method for testing the efficacy of a cosmetic product that affects the texture of the skin, i.e. wrinkles, wherein said method is easy and repeatable.

14. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2284145 ('154) in view of US '502.

GB '154 teaches an anti-aging composition and method for testing its effect on the skin by measuring the depth of the wrinkles and skin firmness by applying adhesive impression mixture uniformly on the test area, then removing it and read it by binocular magnifier (abstract; page 3, lines 22-25; page 4, lines 26-34; page 5, lines 1-2). The test evaluates the structural components of the micro-contour of the skin to evaluate the effect of the cosmetics (page 3, lines 26-30). The impressions are taken on treated skin before applying the cosmetic, and frequently after to test the efficacy of the cosmetic (page 4, lines 14-18, 35-38; page 5, lines 8-14).

The reference does not teach placing the sheet on dark imaging substrate. However, the reference teaches taking impression from the skin surface to evaluate the effect of the skin anti-aging treatment, and one with ordinary skill in the art would have taken impressions from the skin surface using a powder or adhesive. No superior and

unexpected result of record to show the criticality of using the dusting powder, absent evidence to the contrary.

US '502 teaches a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34). The device provides easy application with repeatable results for uniform testing of skin surface (col.2, lines 34-35).

Thus, it would have been obvious to one having ordinary skill in the art the time the invention was made to provide a method for evaluating efficacy of anti-aging treatment on the skin surface by taking impressions on the treated skin before and repeatedly after treatment as disclosed by GB '154, and use adhesive device comprising strip and the dark imaging substrate to visualize the obtained texture as disclosed by US '502, motivated by the teaching of US '502 that the device provides easy application with repeatable results for uniform testing of skin surface, with reasonable expectation of having a method for testing the efficacy of anti-aging agent on the skin, wherein said method is easy and repeatable.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. FR 2,063,743 discloses a process of diagnosis of skin types by

applying an adhesive strip to provide accurate impression of the skin surface and getting imprints of wrinkles that are easy to see.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

IG